

REMARKS

Claims 1-9, 11, 20-21, 23-24, and 26-33 are pending in the present application. By the foregoing amendment, claims 1-3, 5-9, 11, 20-21, 23 and 26-30 have been amended. Claims 10, 12-19, 22, and 25 have been cancelled. Claims 31 and 32 have been added. The remarks below support applicant's assertion that the pending claims are statutory and distinguish over the prior art, and are therefore in condition for allowance.

35 U.S.C. § 101

Initially, in the Office Action, claims 8-30 were rejected under 35 USC 101 (e). It is asserted in the Office Action that claims 8-19 are directed to software per se. In response, it will be noted that claim 8 (as amended), states "A merchandising database system..." comprising "an interface..." and "a storage device...." Clearly, recitation of these elements contemplates more than software per se. Furthermore, the combination of non-software elements cannot add up to software per se. Therefore, applicant asserts that claim 8 as amended is not directed to software per se. Furthermore, since claims 9 and 11 depend from claim 8, these claims include at least the limitations found in claim 8, and therefore are not directed to software per se for the same reason. Thus, applicant asserts that claims 8, 9, and 11 meet the statutory requirements of 35 U.S.C. 101.

It is also asserted that claims 20-30 do not produce a "tangible result." Claim 20 has been amended herein, addressing the rejection under 35 U.S.C. 101. That claim is now directed to a computer-readable storage medium having stored thereon a number of functional software objects. As such, the claim is directed to "functional descriptive material" (as defined by MPEP 2106) recorded on a computer-readable medium. As stated in MPEP 2106, "[w]hen functional descriptive material is recorded on some computer-readable medium it becomes

structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." Thus, claim 20, as amended satisfies the requirements of 35 U.S.C. 101. Claims 21, 23, and 24 depend from and contain all of the limitations of claim 20, and thus those claims must satisfy the statutory requirements of 35 U.S.C. 101 for the same reasons that claim 20 does so. Therefore, applicant asserts that claims 20-21 and 23-24 meet the statutory requirements of 35 U.S.C. 101.

Claims 26-30 were rejected for not producing a tangible results, and more specifically "The result of communicating is still unknown and not being used for populating the merchandising product database as recited in the preamble." Claim 26 has been amended herein to include the step of "modifying the merchandising product databases using the data related to the products such that the databases include a representation of the data related to the products." The result of communicating is thus known, and is being used for modification of the databases. Thus, claim 26 as amended satisfies the requirements of 35 U.S.C. 101. Claims 27-30 depend from and contain all of the limitations of claim 26, and thus those claims must satisfy the statutory requirements of 35 U.S.C. 101 for the same reasons that claim 26 does so. Therefore, applicant asserts that claims 26-30 meet the statutory requirements of 35 U.S.C. 101.

35 U.S.C. § 102(e)

Claims 1-30 were rejected as anticipated under 35 U.S.C. § 102(e) by Musgrove et al. (USP 6,535,880). Applicant respectfully traverses the rejections and asserts that the claims as amended herein patentably distinguish over the disclosure of Musgrove, as discussed below.

Initially, applicant points out that claim 1 as amended is directed to a method of populating a merchandising product database in which product information is obtained "from at least one user interaction ... with a presentation medium" (claim 1, as amended, lines 4-5, emphasis added). Likewise, claim 8 as amended is directed to a merchandising database system including an interface for obtaining "product data...from at least one user interaction...with a Web-page" (claim 8, as amended, lines 4-5, emphasis added). Furthermore, claim 20 is directed to a computer-readable storage medium having stored thereon a software element which obtains "product information from at least one user interaction ... with a Web-page" (claim 20, as amended, lines 6-7, emphasis added). That is, the present invention claimed in claims 1, 8 and 20, and the claims which depend therefrom, obtains information when there is user-interaction (e.g., when the user views a web-page).

This case of obtaining information based on a user's interaction with that information must be distinguished from what is taught by Musgrove, in which a web-crawler (Office Action, page 4, lines 16-18, and Musgrove, col. 5, lines 18-22) "scrapes" content from web sites (e.g., merchant servers 40) independent of whether a user has interacted with that content. This difference is important. In the case of web-crawlers, content (more particularly product information) is obtained without any indication of the significance of that content to the user population. In the case of the collection of data with which a user has interacted (e.g., selection for actual viewing), also referred to in this application as data collection at the point of presentation, the acquired data in and of itself reflects the significance of that content to the user population. For example, the mere fact that certain product information is collected by the merchandising database of the claimed invention indicates that the product has been viewed by a user. Other user-behavioral information (e.g., how many times a product has been viewed, how many people saw the products at a merchant site, the time of the day when the product

was viewed, how the visitors reach the merchant site or the product page) may be inferred from the collected data as well. No such behavioral information could be inferred from product information collected by web-crawlers.

Thus, the limitations of populating a merchandising database with "selected product information from at least one user interaction" (claim 1, as amended, lines 4-5), of a merchandising database system including an interface for obtaining "selected product data...from at least one user interaction...with a Web-page" (claim 8, as amended, lines 4-5, emphasis added), and of a computer-readable storage medium having stored thereon a software element which obtains "product information from at least one user interaction ... with a Web-page" (claim 20, as amended, lines 6-7, emphasis added) are not found in Musgrove. It is well established that "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See also M.P.E.P. § 2131. Thus, since Musgrove fails to teach each element of claims 1, 8, and 20, it cannot render those claims unpatentable under 35 U.S.C. 102(e).

Furthermore, since the various claims depending on claims 1, 8 and 20 contain all of the limitations of those base claims, and limitations in those base claims have been identified above which are not taught by Musgrove, the dependent claims must also contain limitations not found in that sole reference. Therefore Musgrove cannot, pursuant to Verdegaal Bros., supra, render those dependent claims unpatentable under 35 U.S.C. 102(e). More particularly, claims 2-7 and new claim 31 depend from and contain all of the limitations of claim 1; claims 9, 11, and 32 depend from and contain all of the limitations of claim 8; and claims 21, 23-24 and 33 depend

from and contain all of the limitations of claim 20. Accordingly, claims 2-7, 9, 11, 21, 23-24, and 31-33 must be patentably distinct from Musgrove for at least the reasons that claims 1, 8, and 20, respectively, distinguish therefrom.

Additionally, applicant points out the limitation in claim 31 that "the selected information comprises portions of the presentation medium specified by the third network location for storage at the merchandising database at the first network location". Likewise, claim 32 includes the limitation that "the selected product data comprises portions of the Web-page specified by the server at the third network location to be stored in the storage device at the first network location". Furthermore, claim 33 is directed to a computer-readable storage medium having stored thereon computer program codes that "the selected product information comprises portions of the Web-page specified by the server at the third network location to be obtained by the first computer program codes and stored by the second computer program codes". That is, in the present invention claimed in claims 31, 32 and 33, the third network location (e.g., the vendor's web-site) specifies the information to be obtained and stored at the first network location.

Applicant respectfully points out that, in the Musgrove disclosure, the web-crawler does not selectively retrieve any specified information. Rather, the web crawler indiscriminately scrapes the entire content of retrieved web pages. Indeed, Musgrove fails to teach or suggest that a web-crawler needs any direction or permission to "scrape" information off of vendor sites. Whereas, in the invention as claimed in claims 31, 32, and 33, the third network location (e.g., a vendor web-site) is in control – it specifies and thus explicitly permits such information to be transferred to and stored at the third network location. As such, the invention as claimed can be clearly distinguished from the Musgrove disclosure.

Turning next to claim 26 (as amended) and the claims depending therefrom, at least a portion of an interactive catalog is obtained from a third network location and rendered in response to user interaction therewith at a second network location such that selected data from the rendered portion is communicated to a first network location "by way of the second network location" (claim 26, as amended, lines 7-9). An example may help illustrate this concept. Assume an interactive catalog is obtained from a retail server (e.g., third network location) and rendered at a user's computer (e.g., second network location). In displaying, selecting, and viewing portions of that catalog, the user has interactions with that catalog. Data relating to what is rendered is communicated to the merchandising database (e.g., first network location), via the user's computer (e.g., second location), without a direct data transfer between the retail server and the merchandising database.

In contrast, the web-crawler in the Musgrove disclosure obtains data from the vendor web-sites directly. Moreover, the limitations of claim 26 (as amended) of "rendering in response to user interaction...a description of one or more products" (lines 3-4, emphasis added), and "modifying the merchandising product databases using the data related to the products" (line 13) are not found in Musgrove et al. Therefore, applicant asserts that Musgrove fails to teach each element of claim 26 (as amended), and again pursuant to Verdegaal Bros., supra, that reference fails to render claim 26 unpatentable under 35 U.S.C. 102(e).

Furthermore, since claims 27-30 depend from and contain all of the limitations of claim 26, and limitations in claim 26 have been identified above which are not taught by Musgrove, claims 27-30 must also contain limitations not found in that sole reference. Therefore, Musgrove cannot render those dependent claims unpatentable under 35 U.S.C. 102(e).

(Verdegaal Bros., supra.) Accordingly, claims 27-30 must be patentably distinct from Musgrove for at least the reasons that claim 26 distinguishes therefrom.

Finally, while applicant has focused on the common features from the base claims, each of the dependent claims in the present application provide their own additional limitations which may form the basis for distinguishing the reference, although such limitations are not explicitly addressed herein. Thus, applicant reserves the right to argue the differences between the dependent claim limitations and the cited references for a later date, if necessary.

#### **Conclusion**


For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

Appl. No. 10/789,665

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-969-8300.

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